

REMARKS

Applicant hereby responds to the Office Action mailed on March 24, 2004, within the one month extension period. Claims 1-34 remain pending in the application, amended as indicated above. In the Office Action, the United States Patent and Trademark Office (Office) rejected claims 1-14 as failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. The Office took the position that these claims appear to be both an apparatus and a method, and that it is unclear whether the Applicants are attempting to claim the apparatus or the method. The Office interpreted the claims as method claims for purposes of further examination. Without consenting to this rejection, but in the interest of expediting allowance of the claims, Applicants have amended claims 1-14 to create pure method claims instead of system claims, consistent with the interpretation of the Office. Applicants submit that the amended claims 1-14 are fully supported by the original specification and that no new matter has been introduced by reason of these amendments. Further, Applicants respectfully submit that these amendments do not narrow the scope of the claims, and that since the Office made the assumption that the claims were method claims, that no further searching is necessitated as a result of these amendments.

The Office also rejects claims 1-9, 11-13, 15-21, 23-31, and 33-34 as being obviated by a website (InsureMarket) when combined with publication 2002/0002475 (Freedman). Applicants respectfully traverse this rejection. Without consenting to the rejection, Applicants have amended claim 23. Applicants submit that the amended claim 23 is fully supported by the original specification and that no new matter has been introduced by reason of this amendment. Further, since the limitation is found in a similar or less restrictive form in other claims previously pending, Applicants submit that no further searching is necessitated as a result of this amendment.

In response to the obviousness rejection, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness as required under the law. To establish a *prima facie* case of obviousness, the Office must show: (1) a suggestion or motivation to modify the reference or combine reference teachings, (2) a

reasonable expectation of success, and (3) that the references teach or suggest all of the claim limitations. See M.P.E.P. § 2142. At least with the present claims, none of these three basic criteria are present. Applicants respectfully submit that the cited references do not teach or suggest all of the claim limitations of any of the pending claims, that the cited references teach away from the pending claims, and that the pending claims are allowable over the prior art of record.

The Office admitted near the bottom of page 3 of the Office Action that InsureMarket does not disclose facilitating the electronic distribution of proof of coverage to the location of the customer. Rather, the Office stated that this limitation is disclosed in paragraphs 113, 114, and 140 of Freedman. However, Applicants submit that these paragraphs of Freedman do not disclose this limitation, and that Freedman, taken as a whole, teaches away from this limitation. Paragraph 114 of Freedman discloses issuing temporary binders, but does not teach or suggest "facilitating the electronic distribution of proof of coverage to the location of the customer" as recited in claim 1, for example. In other words, although Freedman teaches temporary binders, the present invention goes beyond the teachings of the prior art and claims "facilitating the electronic distribution of proof of coverage to the location of the customer". All of the other currently pending independent claims 15, 23, and 26, also contain similar elements.

In fact, in contrast to the pending claims, Freedman, when taken as a whole, teaches against issuing binders until an inspection of the vehicle is performed. See, for example, paragraphs 114, 125, 148, 151, 259, and 262 of Freedman, which all indicate that inspections are to be performed before issuing a binder. Thus, Freedman teaches away from facilitating the electronic distribution of proof of coverage to the location of the customer. This negates any motivation to combine Freedman with another reference to arrive at the present invention, and also negates any reasonable expectation of success.

The importance of this difference may be illustrated, for example, in the case of claims 10, 14, 22, and 32, where the coverage is for insurance in a country other than the one in which the customer resides, such as Americans entering Mexico, or vice versa. The customer may need a binding insurance contract and proof of such

insurance, for automobile insurance, for instance, in order to enter the country. The ability to have proof of insurance printed electronically at the location of the customer is a significant advantage in convenience for the customer that may translate into more business for the user of such a method. The insurance industry is a competitive industry, and if such a step were obvious, others would have used it earlier. Applicants submit that "facilitating the electronic distribution of proof of coverage to the location of the customer" was not obvious, at least not without the benefit of hindsight.

Further, the Office stated on page 3 of the Office Action that InsureMarket discloses, on the page titled "How InsureMarket Works", the limitation of claim 1: "contracting with insurance companies to sell the companies' insurance policies in accordance with the policy information". However, Applicants submit that such a contract is not taught or suggested by InsureMarket. First, there is no explicit statement in InsureMarket that they have entered into a contract with insurance companies to sell insurance policies. Second, Applicants submit that if InsureMarket had entered into a contract with insurance companies to sell the companies' insurance policies in accordance with the policy information, that InsureMarket would be able to enter into a contract with the customer on behalf of the insurance company to effectuate such a sale. However, a contract requires both an offer and acceptance, and while InsureMarket discloses applying for insurance coverage online, and offering payment, InsureMarket does not disclose that the insurance company is bound as a result of the customer's online interaction with InsureMarket. Thus, InsureMarket is not "selling" insurance, but is just referring offers made by potential customers to the insurance company, who is the entity that actually sells the insurance to the customer. Consequently, InsureMarket does not teach or suggest the limitation of "contracting with insurance companies to sell the companies' insurance policies in accordance with the policy information" and in fact leads away from such an arrangement.

Applicants admit that they are not the first to invent the concept of an entity "contracting with insurance companies to sell the companies' insurance policies in accordance with the policy information" as recited in claim 1, but Applicants submit that predecessors have not combined this limitation with the other limitations of claim 1. Thus, the present invention goes beyond such predecessors, as well as going beyond

InsureMarket. Further since InsureMarket teaches away from "contracting with insurance companies to sell the companies' insurance policies in accordance with the policy information", it would not be proper to combine InsureMarket with another reference that taught this missing limitation.

Similarly, Freedman teaches away from "contracting with insurance companies to sell the companies' insurance policies in accordance with the policy information" by stating that binders are not issued (*i.e.*, the insurance company is not bound) until the company inspects the vehicle (paragraph 125) and the "company underwriters review the data for accuracy and verify driving records".

The Office also rejected claims 10, 14, 22, and 32 as being obvious in view of the previously cited references plus Publication 2003/0004759 (Chapman). Applicants respectfully submit that Chapman does not obviate any of the pending claims because Chapman does not teach or suggest the limitations identified above as being missing from the other references.

Applicants further submit that the dependent claims are allowable because they are dependent on allowable independent claims. Applicants submit that the dependent claims may have additional limitations that further distinguish them from the references cited, and Applicants reserve the right to bring these other limitations to the attention of the Office in the event the need should arise.

In conclusion, Applicants respectfully submit that the cited references do not teach or suggest all of the limitations of any of the pending claims. Further, Applicants respectfully submit that the cited references teach away from their combination with any other reference to arrive at the present invention, and that the cited references further lead away from an expectation of success. In view of the foregoing, Applicants respectfully submit that the pending claims are allowable over the prior art of record.

Accordingly, Applicants respectfully request reconsideration of the application and allowance of all pending claims. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, the Examiner is invited to telephone the undersigned.

Respectfully submitted on behalf of
AMERICAN EXPRESS TRAVEL RELATED
SERVICES, INC., Assignee,

Date: 7-16-04

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